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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/359,809	07/23/1999	RICHARD LEVY	01064.0011-0	3299

7590 12/03/2003

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EXAMINER	
MEDLEY, MARGARET B	

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/359,809	LEVY, RICHARD	
	Examiner	Art Unit	
	Margaret B. Medley	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 57-72* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,57,58,63,64,69 and 70* is/are rejected.

7)☒ Claim(s) *59-62,65-68,71 and 72* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *9/03* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This action is in response to the paper dated September 8, 2003 by applicant to the USPTO.

The pending claims of record are claims 1 and 57-72. Claims 1, 57 and 59 were amended.

Claim 72 was newly added. The examiner takes the position on record that the "substantially anhydrous" will be read in light of the definition set forth on pages 31-32 of the instant application wherein applicant indicates that the written description supports the amendment of claim 72.

The previous rejections under 35 U.S.C. 103 and 112 second and first paragraphs are withdrawn in view of applicant's arguments and amendments made to the instant claims of record.

The changes are as follows: The rejection of claims 59-62, 65-68 and 71-72 under 35 U.S.C. section 103(a) is withdrawn in view of applicant's detailed and convincing arguments presented in the paper dated September 8, 2003. The said claims 59-62, 65-68 and 71-72 are now objected to for depending on claims that are rejected under the Section of 35 U.S. C. 103 (a).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 remain rejected under 35 U.S.C. 102(b) as being anticipated by Hopkins Jr. et al U.S. 5,362,788 in combination with the Merck Index, and Admitted Prior Art for reasons previously made of record in the June 12, 2003 office action.

Claims 1, 57, 63, 69 and 70 remain rejected under 35 U.S.C. 102(b) as being anticipated by Admitted Prior Art of Levy 4,985,251.

Claims 1, 57-58, 63-64 and 69-70 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Geursen et al (Geursen) WO 93/18233 that has matured into its US Counterpart 5,534,304 for reasons previously made of record in the June 12, 2003 office action.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-72 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29-43 of copending Application No. 09/357,957. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons made of record in the paper dated June 12, 2003.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed September 08, 2003 have been fully considered but they are not persuasive.

Applicant's arguments directed to the rejection of claims 1, 57-58, 63-64 and 69-70 under 35 U.S. C. Section 102 (b) as anticipated by Geursen are unpersuasive because the arguments are not commensurate in scope with the breath of the instant claims. The instant pending claims as drafted are not specific to any substrate and encompass the substrate of the relied on prior art. The arguments presented in the amendment dated September 8, 2003 are directed to the swell index of the of the fiber along with the SAP wherein the instant claims are only directed to the property of the SAP having the ability to absorbs greater than about 100 times its weight in water. The SAP of Geursen clearly have the ability to absorb from 50 to 700 or higher, more particularly from 100 to 700 or higher its weight in water, note the bridging paragraph of pages 12-13.

It is further noted that applicant's arguments set forth on pages 11-19 of the same response are related to the background of Geursen and is not the teaching of the invention of patentee. Therefore, the arguments are unpersuasive because Geursen clearly teaches that their SAP are derivatives of polyacrylic acid and that the said SAP are rendered insoluble in water by ionic and/or covalent cross-linking, note the second full paragraph of page 6, particularly the last two lines. Preferably, Geursen makes use of a terpolymer of acrylamide and carboxyl

groups- and sulpho groups-containing monomers (sodium salt) or, of a polyacrylamide copolymer, the Mirox W 45985 of Example 1, note pages 16-17. Applicant's' arguments set forth on pages 11-19 of the same response are further directed to the same issues with respect to Geursen addressed above. The said arguments are rebutted by the teachings of Geursen set forth supra.

Applicant indicates that the traversal of Hopkins is addressed on page 11-14 of the arguments. However all of the traversals are directed to Geursen and the rebuttal are set forth above.

Applicant indicates that the traversal of Admitted Prior Art Levy U.S. 4,985,251 is addressed on pages 14-16 of the arguments. However all of the traversals are directed to Geursen and the rebuttal are set forth above.

Applicant's arguments set forth on pages 19-20 of the same response are directed to the rejection set forth under 35 U.S.C.103 are deemed moot in that the said rejection has been withdrawn.

The examiner maintains the position stated of record that claims 57-72 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 29-43 of co-pending application Serial No. 09/357,957 for reasons made of record. Other than the preamble of the related case the claims of both applications involve a one step process for producing lubricating composition and lubricating compositions.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday from 7:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 703-306-2777 phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Margaret B. Medley
Primary Examiner
Art Unit 1714

MBMedley
December 1, 2003